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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/764,110	12/06/1996	YUHPYNG L. CHEN		4202

7590 10/27/2003

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26 West 61st Street
New York, NY 10023

EXAMINER

BERCH, MARK L

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/27/2003

43

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

08/764,110

Applicant(s)

CHEN, YUHPYNG L.

Examiner

Mark L. Berch

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 July 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 8/29/2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See memo.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See memo.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 2-4, 8-10, 12-14, 18, 25.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Mark L. Berch
Primary Examiner
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DETAILED ACTION

Pursuant to the petition decision of 9/22/2003, this application is revived.

The amendment filed 7/27/02 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: The proposed amendment raises new issues that would require further consideration.

The proposed revision to the $CR^1R^2R^3$ ring definition expands the definition of the ring, and thus introduces new matter. Previously, all of the bonds had to be single bonds, although one to three of the C-C or C-N single bonds could be converted into a double bond. With the proposed change, that requirement exists only when the $CR^1R^2R^3$ ring is carbocyclic. As a result, one could now start with a non-carbocyclic $CR^1R^2R^3$ ring which had 4 double bonds, or had a triple bond, which the specification does not permit.

Even if the amendment had been entered, points 1-3 would not have been fixed. The remarks on page 9 under "1)" seem to indicate that applicants believe that the ring starts off as carbocyclic, and replacements are possible when ring size is 5-8. That is simply not true. It just says, "3 to 8 membered ring" at the beginning. Thus, the original ring could be e.g. a C-bond azetidine, which as previously indicated is not in the specification.

The traverse on the R^4 as CF_3 issue is unpersuasive. Applicants point to original claim 1, but that claim language did not embrace this CF_3 group. Applicants argue with regard to the page 9 text that "each of these definitions should be taken separately". However, as the examiner pointed out previously, the semicolon means "and". That is its normal meaning. For applicants' reading to be correct, the semicolon would have to

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be understood as "or". This is not a matter of the examiner taking a "restricted view". The plain, ordinary meaning of a semicolon is "and" and applicants have presented no rationale for understanding it as "or".

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.



Mark L. Berch
Primary Examiner
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10/21/2003